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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,111	11/29/2000	Erin M. Bourke-Dunphy	MS160276.1	1795
27195	7590	02/06/2004	EXAMINER	
AMIN & TUROCY, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			NAHAR, QAMRUN	
			ART UNIT	PAPER NUMBER
			2124	6

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,111

Applicant(s)

BOURKE-DUNPHY ET AL.

Examiner

Qamrun Nahar

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the amendment filed on 11/24/03.
2. The objections to claims 3-5, 10-11 and 20 are withdrawn in view of applicant's amendments.
3. Claims 1, 3-5, 10-11, 14, 20-21, 28, 31, 35 and 39 have been amended.
4. Claims 1-39 are pending.
5. The objection to claim 31 is pending.
6. Claims 1-39 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. 5,666,501).

### *Claim Objections*

7. Claim 31 is objected to because of the following informalities: the amendment to the claim is not proper. Claim 31 is interpreted as:

The computer-readable medium of claim 30, wherein **the** computer-readable instructions for sensing an attribute associated with the computer system ~~attribute comprises~~ **comprise** computer-readable instructions for sensing a registry key.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. 5,666,501).

**Per Claim 1 (Amended):**

The Jones patent discloses:

- **a software tool for installing a software component on a computer system** (“A computer-implemented method, apparatus, and memory embodying computer-readable code install software located on a second machine to a first machine in a distributed computing network.” in column 1, lines 62-65)

- **a user interface component adapted to render a plurality of setup prompts to a user and to obtain a user command** (“The method includes the step of displaying installable software residing in one or more source objects of the second machine that is installable on the first machine. In response to a selection by user controls of at least one of the displayed source objects, the method also includes the step of displaying software bundle objects having software items, where at least one of the software items is in common (i.e., identical) with one of the software items in the selected source object.” in column 1, lines 66-67 to column 2, lines 1-7)

- **and a setup component adapted to sense an attribute of a registry associated with the computer system, to selectively provide at least one setup prompt to the user interface**

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**component according to the attribute, and to selectively install the software component on the computer system according to the user command** (“If one of the software bundle objects is selected, the method further includes the step of installing on the first machine an intersection ... of the software items of the source object and the software items of the selected bundle object ... Display controls 245 allow user control and manipulation of the contents of panel 240. The user can apply the controls to a single item in panel 240, the highlighted (selected) items in panel 240, or all items in panel 240. ... Display control 247 expands the items in panel 240 to show any fixes available (a fix is a corrective update to the software after its initial release). ... Display control 250 allows the user to sort the contents of panel 240 by type, date, name, or any other attribute. Display control 251 allows the user to search the contents of panel 240 based on type, date, name, or any other attribute.” in column 2, lines 7-12; and column 3, lines 59-67 to column 4, lines 1-15; it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system; that is, a registry maintains information on installed components. Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed yet.).

**Per Claim 2:**

The Jones patent discloses:

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- wherein the setup component is adapted to selectively suppress at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary (column 3, lines 59-67 to column 4, lines 1-15; and column 4, lines 51-63).

**Per Claim 3 (Amended):**

The Jones patent discloses:

- wherein the at least one setup prompt comprises a selection between at least two setup parameters, and wherein the setup component is adapted to select one of the at least two setup parameters according to the attribute (column 4, lines 51-63).

**Per Claim 4 (Amended):**

The Jones patent discloses:

- wherein the setup component is adapted to selectively install the software component on the computer system using the selected one of the at least two setup parameters (column 5, lines 29-34).

**Per Claim 5 (Amended):**

The Jones patent discloses:

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- wherein the attribute comprises data stored in the computer system (column 4, lines 40-63).

**Per Claim 6:**

The Jones patent discloses:

- wherein the data comprises a registry key (column 3, lines 59-67 to column 4, lines 1-15; it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system; that is, a registry maintains information on installed components. Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed yet. A registry key is used to access a registry.).

**Per Claim 7:**

The Jones patent discloses:

- wherein the software component comprises one of an operating system and an application (column 3, lines 59-67 to column 4, lines 1-15).

**Per Claim 8:**

The Jones patent discloses:

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- wherein the software component comprises a plurality of program components, and wherein the setup component is adapted to selectively install at least one of the plurality of program components according to tile attribute (column 3, lines 59-67 to column 4, lines 1-15; and column 4, lines 40-54).

**Per Claim 9:**

The Jones patent discloses:

- wherein the at least one setup prompt comprises a selection between at least two setup parameters, and wherein the setup component is adapted to select one of the at least two setup parameters according to the attribute (column 4, lines 51-63).

**Per Claim 10 (Amended):**

The Jones patent discloses:

- wherein the setup component is adapted to selectively install the software component on the computer system using the selected one of the at least two setup parameters (column 5, lines 29-34).

**Per Claim 11 (Amended):**

The Jones patent discloses:



- **wherein the attribute comprises a registry key** (column 3, lines 59-67 to column 4, lines 1-15; it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system; that is, a registry maintains information on installed components.

Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed yet. A registry key is used to access a registry.).

**Per Claim 12:**

The Jones patent discloses:

- **wherein the software component comprises one of an operating system and an application** (column 3, lines 59-67 to column 4, lines 1-15).

**Per Claim 13:**

The Jones patent discloses:

- **wherein the software component comprises a plurality of program components, and wherein the setup component is adapted to selectively install at least one of the plurality of program components according to the attribute** (column 3, lines 59-67 to column 4, lines 1-15; and column 4, lines 40-54).

**Per Claim 14 (Amended):**

The Jones patent discloses:

- **a software setup tool for performing a setup operation in a computer system** (“A computer-implemented method, apparatus, and memory embodying computer-readable code install software located on a second machine to a first machine in a distributed computing network.” in column 1, lines 62-65)
  
- **a setup component adapted to sense an attribute of a registry associated with the computer system and to selectively provide one of standard prompting and special prompting to a user according to the attribute** (“If one of the software bundle objects is selected, the method further includes the step of installing on the first machine an intersection ... of the software items of the source object and the software items of the selected bundle object ... Display controls 245 allow user control and manipulation of the contents of panel 240. The user can apply the controls to a single item in panel 240, the highlighted (selected) items in panel 240, or all items in panel 240. ... Display control 247 expands the items in panel 240 to show any fixes available (a fix is a corrective update to the software after its initial release). ... Display control 250 allows the user to sort the contents of panel 240 by type, date, name, or any other attribute. Display control 251 allows the user to search the contents of panel 240 based on type, date, name, or any other attribute.” in column 2, lines 7-12; and column 3, lines 59-67 to column 4, lines 1-15; it is inherent that a setup component is adapted to sense an attribute of a registry

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associated with the computer system; that is, a registry maintains information on installed components. Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed yet.)

- **and a user interface component adapted to render a plurality of setup prompts to a user and to obtain at least one setup parameter** ("The method includes the step of displaying installable software residing in one or more source objects of the second machine that is installable on the first machine. In response to a selection by user controls of at least one of the displayed source objects, the method also includes the step of displaying software bundle objects having software items, where at least one of the software items is in common (i.e., identical) with one of the software items in the selected source object." in column 1, lines 66-67 to column 2, lines 1-7).

**Per Claim 15:**

The Jones patent discloses:

- **wherein the setup component is further adapted to selectively perform at least one setup operation according to the at least one setup parameter and the attribute** (column 4, lines 51-63).

**Per Claim 16:**

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The Jones patent discloses:

- **wherein the attribute comprises a registry key** (column 3, lines 59-67 to column 4, lines 1-15; it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system; that is, a registry maintains information on installed components. Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed yet. A registry key is used to access a registry.).

**Per Claim 17:**

The Jones patent discloses:

- **wherein the setup component is further adapted to selectively suppress at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary** (column 3, lines 59-67 to column 4, lines 1-15; and column 4, lines 51-63).

**Per Claim 18:**

The Jones patent discloses:

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- wherein the at least one setup prompt comprises a selection between at least two setup parameters, and wherein the setup component is adapted to select one of the at least two setup parameters according to the attribute (column 4, lines 51-63).

**Per Claim 19:**

The Jones patent discloses:

- wherein the setup component is adapted to selectively install a software component on the computer system using the selected one of the at least two setup parameters (column 5, lines 29-34).

**Per Claim 20 (Amended):**

The Jones patent discloses:

- wherein the setup component is adapted to one of render at least one additional setup prompt to the user according to the attribute, and render at least one substitute setup prompt to the user according to the attribute (column 3, lines 59-67 to column 4, lines 1-15; and column 4, lines 51-63).

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**Per Claims 21 (Amended) & 22:**

These are method versions of the claimed software setup tool discussed above, claim 14, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Jones.

**Per Claims 23-24:**

These are method versions of the claimed software setup tool discussed above (claims 15 and 16, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Jones.

**Per Claim 25:**

This is a method version of the claimed software setup tool discussed above, (claims 17 and 20), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Jones.

**Per Claims 26-27:**

These are method versions of the claimed software setup tool discussed above, (claims 18 and 19, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Jones.

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**Per Claims 28 (Amended) & 29-30, 31 (Amended) & 32-34:**

These are computer-readable medium versions of the claimed method discussed above, (claims 21-27, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Jones.

**Per Claims 35 (Amended) & 36-38:**

These are software tool versions of the claimed method discussed above, (claims 21-22 and 24-25, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Jones.

**Per Claim 39 (Amended):**

This is a data packet version of the claimed software tool discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Jones.

***Response to Arguments***

10. Applicant's arguments filed on 11/24/03 have been fully considered but they are not persuasive.

*In the remarks, the applicant argues that:*

a) As amended, claim 1 recites in part that the "...setup component [is] adapted to *sense an attribute of a registry associated with the computer system*, to selectively provide at least one

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setup prompt to the user interface component according to the attribute, and to selectively install the software component on the computer system according to the user command." Jotres *et al.* neither teaches nor suggests a software tool that senses a registry attribute to install software as in the claimed invention. A similar limitation is recited in amended independent claims 14, 21, 28, 35, and 39. Thus, Applicants' representative submits that these claims and those that depend therefrom are no longer anticipated by Jones *et al.* and should be allowed.

With respect to claims that recite a "registry key" (e.g., claim 6), the Examiner indicates that Jones *et al.* discloses such limitation. Applicant's representative respectfully disagrees- Portions of the reference cited by the Examiner as being relevant thereto do not disclose such a limitation. In fact, nowhere in Jones *et al.* is the term "registry" used.

Moreover, it would not have been obvious to one; skilled in the art to use the system and methods of Jones *et al.* to achieve the benefits of the subject invention as claimed. Jones *et al.* teaches manual manipulation of the software *selection* and installation process via the GUI. *In contrast*, claimed aspects of the subject invention use a software tool that includes a setup component that senses a registry attribute and selectively provides in accordance therewith a setup prompt to allow the user to install the software or portions thereof. Accordingly, it would not have been obvious to one skilled in the art to use or adapt the architecture of Jones *et al.*

*Examiner's response:*

a) Examiner strongly disagrees with applicant's assertion that Jones fails to disclose the claimed limitations recited in claims 1, 14, 21, 28, 35, and 39. Jones clearly shows each and every limitation in claims 1, 14, 21, 28, 35, and 39. As previously pointed out in Paper no. 4,



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Jones teaches a setup component adapted to sense an attribute of a registry associated with the computer system, to selectively provide at least one setup prompt to the user interface component according to the attribute, and to selectively install the software component on the computer system according to the user command (column 2, lines 7-12; and column 3, lines 59-67 to column 4, lines 1-15; it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system; that is, a registry maintains information on installed components. Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed yet.).

Furthermore, with respect to claims that recite a "registry key" (e.g. claim 6), a registry key is used to access a registry. In order to access the registry to find out information of the components that are installed already or of the components that are not installed yet, a registry key has to be used.

In addition, see the rejection above in paragraph 9 for rejection to claims 1-39.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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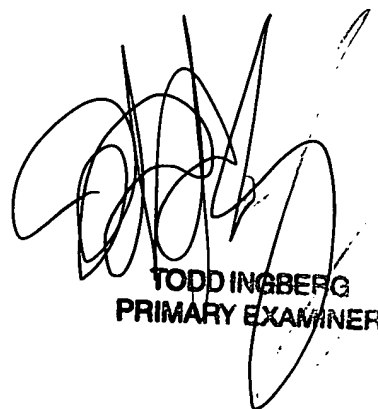
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN  
January 27, 2004



TODD INGBERG  
PRIMARY EXAMINER